

Application No.: 09/904124

Case No.: 56908US002

Remarks

Claims 1-7 and 10-21 remain pending. Claim 21 has been withdrawn from consideration.

§ 103 Rejections

Claims 1-7, 10, and 15-20 stand rejected under 35 USC § 103(a) as being unpatentable over Munzenberger et al. (US 6,161,393) in view of Rodriquez et al. (US 5,588,267).

Claims 11-14 stand rejected under 35 USC § 103(a) as being unpatentable over Munzenberger et al. (US 6,161,393) in view of Rodriquez et al. (US 5,588,267) and further in view of Radke et al. (US 6,694,684).

Regarding Applicant's argument that the Rodriquez et al. reference is non-analogous art, the Examiner has argued that the Rodriquez reference is "considered to be readable on the applicants [sic] invention." This, however, is not the test for determining whether a reference is analogous, and the Examiner has failed to provide any reasoning as to: (1) why the Rodriquez reference would be considered to be in the applicant's field of endeavor, namely firestopping, or (2) why it would be considered reasonably pertinent to the particular problem with which the inventor was concerned, namely creating a firestop opening in a partition and adjusting the height of the firestop device to match the thickness of the partition. Accordingly, the Examiner has failed to rebut Applicant's argument that Rodriquez et al. is non-analogous art. Reconsideration is requested.

Regarding the motivation to combine the teachings of the Munzenberger et al. and Rodriquez et al. references, the Examiner states that "the motivation of the rejection is found that by using the housing of Rodriquez, firestop material could be placed within the housing along the pipe (P) in order to slow down rate of fire from passing from one part of the housing to the next." Applicant notes, however, that this can be accomplished with the Munzenberger device alone, so there would be no reason to modify the Munzenberger device for this purpose. In addition, the Rodriquez roof flashing is not designed or intended to be secured to a wooden concrete form, is not designed or intended to be embedded in a concrete partition to create an opening in the partition, and is not designed or intended to prevent the spread of fire or smoke. Accordingly, there would be no reason to modify the Rodriquez device as suggested by the Examiner.

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In addition, the Examiner's reasoning appears to exemplify a case of impermissible hindsight reconstruction, wherein the cited references are being modified to arrive at the present invention only because of the knowledge of applicants' own disclosure. Without the benefit of Applicants' application, however, one having knowledge of the Munzenberger et al. or Rodriquez et al. teachings would have no reason to modify either device in a manner required to meet the claims, and would therefore not be able to arrive at the present invention as defined in claims 1-7 and 10-20. Accordingly, the rejection of claims 1-7 and 10-20 as being unpatentable over Munzenberger et al. in view of Rodriquez et al. is unwarranted and should be withdrawn. If this rejection is to be maintained, the Examiner is again requested to explain why one of ordinary skill in the art would be motivated to modify the references or combine the reference teachings in a manner required to meet the claims.

Regarding the Examiner's characterization of the reference numeral 15 in the Munzenberger reference as a rib, even if the number 15 identifies a rib, which Applicant does not concede, claims 5, 18 and 20 recite a device including ribs. In addition, claim 20 further recites that the ribs extend longitudinally from the first open end of the device to the shoulder portion along the inner surface of the sidewall, thereby defining a gap between the intumescent material and the sidewall inner surface. Munzenberger et al. fail to disclose such ribs.

As explained on page 8, lines 19-24 of the specification, the ribs 14a maintain the firestop material in spaced relation from the sidewall and thereby create an air gap between the firestop material and the side wall portion which, in the event of a fire, allows the entire axial length of the firestop material to be exposed to heated air, thereby aiding rapid, complete, and uniform expansion of the firestop material which in turn closes the through-penetration. Because the Munzenberger locking ring 15 extends radially inwardly (rather than longitudinally along the sidewall inner surface), it would actually prevent the entire length of firestop material from being exposed to heated air.

Regarding the rejection of claims 11-14 and the use of the Radke et al. patent 6,694,684 as a prior art reference, Applicant respectfully notes that because this patent qualifies as prior art only under 35 USC § 102(e), and because the subject matter of the 6,694,684 patent and the present application were subject to an obligation of assignment to the same person at the time the

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invention was made, the 6,694,684 patent cannot be used to preclude patentability under 35 USC § 103. Reconsideration is requested.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Respectfully submitted,

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